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Filing date: **09/26/2006**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91165809
Party	Defendant Nalge Nunc International Corporation Nalge Nunc International Corporation 75 Panorama Creek Drive Rochester, NY 146020365
Correspondence Address	DONALD F. FREI WOOD, HERRON & EVANS, L.L.P. 2700 CAREW TOWER 441 VINE STREET CINCINNATI, OH 45202-2917
Submission	Defendant's Notice of Reliance
Filer's Name	Brett A. Schatz
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Signature	/Brett A. Schatz/
Date	09/26/2006
Attachments	Notice of Reliance-Admissions.pdf ( 3 pages )(84300 bytes ) NOR-Admissions-Attachment.pdf ( 8 pages )(298940 bytes )

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

<u>In re Application, Serial No. 76/572,253</u>	)	
TriForest Enterprises, Inc.	)	
	)	Opposition No. 91165809
Opposer,	)	
v.	)	
	)	
Nalge Nunc International Corporation	)	
	)	
Applicant-Respondent.	)	
_____	)	

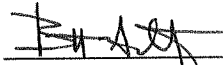
Commissioner for Trademarks  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

**APPLICANT NALGE NUNC INTERNATIONAL CORPORATION'S  
NOTICE OF RELIANCE ON OPPOSER TRIFOREST ENTERPRISES, INC.'S  
RESPONSE TO APPLICANT'S FIRST SET OF REQUESTS FOR ADMISSIONS**

Applicant Nalge Nunc International Corporation hereby provides notice of its reliance upon portions of Opposer TriForest Enterprises, Inc.'s Response to Applicant's First Set of Requests for Admissions. The portions of Opposer TriForest Enterprises, Inc.'s Response to Applicant's First Set of Requests for Admissions upon which Applicant relies are attached hereto.

Respectfully submitted,

Dated: September 26, 2006



Theodore R. Remaklus, Esq.  
Brett A. Schatz, Esq.  
Sarah Otte Graber, Esq.  
WOOD, HERRON & EVANS, L.L.P.  
441 Vine Street, 2700 Carew Tower  
Cincinnati, Ohio 45202  
(513) 241-2324  
Attorneys for Applicant  
Nalge Nunc International Corporation

**CERTIFICATE OF TRANSMISSION**

I hereby certify that this correspondence is being transmitted electronically to the United States Patent and Trademark Office, Trademark Trial and Appeal Board on the date shown below.

Date: September 26, 2006

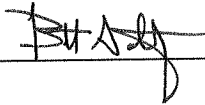


Anita L. Freeman

**CERTIFICATE OF SERVICE**

I hereby certify that the foregoing **APPLICANT NALGE NUNC INTERNATIONAL CORPORATION'S NOTICE OF RELIANCE ON OPPOSER TRIFOREST ENTERPRISES, INC.'S RESPONSE TO APPLICANT'S FIRST SET OF REQUESTS FOR ADMISSIONS** was served by e-file copy and by Federal Express, Two-Day Delivery, upon counsel for Opposer TriForest Enterprises, Inc., Clement Cheng, Esq., Law Offices of Clement Cheng, 17220 Newhope Street, Suite 127, Fountain Valley, California 92708, on this 26th day of September, 2006.

Dated: September 26, 2006

  
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

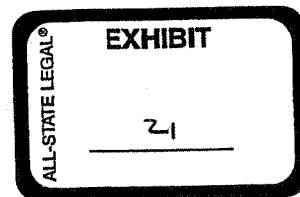
In re Application, Serial No. 76/572,253	)	
TriForest Enterprises, Inc.	)	
	)	Opposition No.: 91165809
Opposer,	)	
	)	
Nalge Nunc International Corporation,	)	
	)	
Applicant/Respondent.	)	
	)	

**OPPOSER, TRIFOREST ENTERPRISES, INC.'S RESPONSE TO APPLICANT'S  
FIRST SET OF REQUESTS FOR ADMISSIONS**

**REQUEST FOR ADMISSION NO. 2:**

Admit that Opposer may produce and sell drinking water bottles having a different shape from Applicant's Mark.

**RESPONSE TO REQUEST FOR ADMISSION NO. 2:**



Admitted. Opposer sells various general purpose bottles not limited to drinking water or laboratory use, however, due to the increase in the number of trade dress claims, and cease and desist letters received from Apogent, the scope of the trademark is broadened after registration such that applicant later claims infringement against wide variety of opposers products. Based on previous correspondence, it appears that Apogent (parent company of Nalgene) has an expansive view of the trademark scope. Furthermore, the scope of the trademark claims seems to grow over time so this admission relates only to the present time.

**REQUEST FOR ADMISSION NO. 3:**

Admit Opposer has sold, produced and distributed drinking water bottles that have a different shape from Applicant's Mark.

**RESPONSE TO REQUEST FOR ADMISSION NO. 3:**

Admitted. However, Applicant's numerous trade dress claims are overbroad such that they encompass all of opposer's products. Opposer sells various bottles for a general purpose, not limited to drinking water or laboratory use however, opposer's distributors have received cease and desist letters when only a small number of factors match the numerous list of trade dress elements.

**REQUEST FOR ADMISSION NO. 4:**

Admit that the goods referred to in Admission No. 3 had a cap, a tether and a mouth.

**RESPONSE TO REQUEST FOR ADMISSION NO. 4:**

Admitted. All of Opposer's bottles have a cap and a mouth. Some of Opposer's bottles have a connector (tether) to provide convenience and prevention of loss of the cap. The bottles in reference all have a closure of 38/430, which is a generally popular neck size in laboratories. The bottles come with a choice of a tethered cap, filtered cap, a rubber septum cap or a sealed non tethered cap. Opposer's bottles that have a tethered cap serve a utility function and are essential for use in a sterile environment. If the Applicant were to succeed in registering its trademark, any person or company who manufactures a Boston Round bottle with a closure measuring 38/430 would infringe on a trademark.

**REQUEST FOR ADMISSION NO. 8:**

Referring to the bottles shown on Exhibit 1 attached to the Notice of Opposition, admit that Applicant's Mark is different in appearance from:

- a. Product #5180, On the Trail Square Polycarbonate bottle;
- b. Product #5190, The Journeyer Polycarbonate bottle;
- c. Product #5196, The Outfitter Polycarbonate bottle;
- d. Product #4663, the Flavor Fresh Polycarbonate bottle;

- e. Product #5081, the Rx Collapsible water bottle.

**RESPONSE TO REQUEST FOR ADMISSION NO. 8:**

There is some difference in appearance, but that is a matter of degree that can be debated. However, once the trademark issues, the opposer and its distributors will begin receiving cease and desist letters from Apogent (parent company of Nalgene) claiming trademark infringement. This will cut into sales and hurt the opposer, which is why the opposer is filing this opposition.

**RESPONSE TO REQUEST FOR ADMISSION NO. 11:**

Admit that the Owens-Illinois website referenced in the Notice of Opposition does not refer to any plastic drinking water bottles.

**RESPONSE TO REQUEST FOR ADMISSION NO. 11:**

Not sure, applicant and opposer will have to check on this. It appears that the bottles are made of plastic, however they could very well be made of glass also.

**REQUEST FOR ADMISSION NO. 12:**

Admit that Owens-Illinois does not manufacture and/or provide plastic drinking water bottles.

**RESPONSE TO REQUEST FOR ADMISSION NO. 12:**

Not sure, Opposer does not have sufficient knowledge or information to know the purpose for which Owens-Illinois Boston Round bottles are used.



**REQUEST FOR ADMISSION NO. 13:**

Admit that the Brockaway Glass website referenced in the Notice of Opposition does not refer to any plastic drinking water bottles.

**RESPONSE TO REQUEST FOR ADMISSION NO. 13:**

Not sure, Opposer does not have sufficient knowledge or information re: the Brockaway Glass company product.

**REQUEST FOR ADMISSION NO. 14:**

Admit that Brockaway Glass does not manufacture and/or provide plastic drinking water bottles.

**RESPONSE TO REQUEST FOR ADMISSION NO. 14:**

Not sure, Opposer does not have sufficient knowledge or information to know the purpose for which Brockaway Glass Boston Round bottles are used. However the plastic water bottles appeared to be not for drinking. Obviously, someone can drink from the water bottle however the opposer will investigate this matter.

**REQUEST FOR ADMISSION NO. 18:**

Admit that Applicant's Mark is not the only design available for a plastic drinking water bottle.

**RESPONSE TO REQUEST FOR ADMISSION NO. 18:**

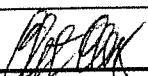
Admitted. Applicant's mark is not the only variation of the Boston Round design. Other bottle manufacturers, also use modified versions of their Boston Round design bottles as plastic drinking water bottles.

**REQUEST FOR ADMISSION NO. 19:**

Admit that there are alternative designs for plastic drinking water bottles that are less expensive to manufacture than plastic drinking water bottles bearing Applicant's Mark.

**RESPONSE TO REQUEST FOR ADMISSION NO. 19:**

Denied. Opposer incurred substantial cost to make numerous design modifications after receiving threats from Apogent. Bottle manufacturers, including Applicant, sell less expensive bottles that are variations of the plastic drinking water bottles bearing Applicant's Mark. However, opposer would have saved a substantial amount of money if applicant did not make any trademark claims.

2/28/06	
Date  <small>Z:\Client 2. @ TM\TTAB\TriForest Ent v. Nalgene 76572253\TriForest's Response to Applicant's Request for Admissions.doc</small>	Clement Cheng, attorney for applicant Law Office of Clement Cheng 17220 Newhope St Ste 127 Fountain Valley, CA 92708-4283 (714) 825-0555 (714) 825-0558 fax

**PROOF OF SERVICE**

**In the matter of App Ser. No. 76/572,253**

I, the undersigned, declare I am over the age of 18 and not a party to this action. My business address is at 17220 Newhope St., Suite 127 Fountain Valley, CA 92708.

On February 28, 2006, I served:

**TRIFOREST ENTERPRISES, INC.'S RESPONSE TO APPLICANT'S REQUEST FOR ADMISSION**

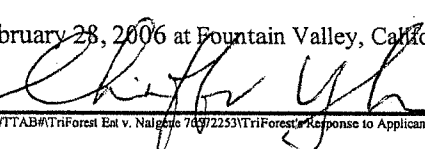
By placing true copies thereof in a seal envelope, addressed as follows to:

Donald L. Frei  
Sarah Otte Graber  
WOOD, HERRON & EVANS, LLP  
2700 Carew Tower  
441 Vine Street  
Cincinnati, OH 45202-2917  
(513) 241-2324

Attorney's for Applicant Nalge Nunc International Corporation

- ☐ BY PERSONAL SERVICE: I caused such envelope to be delivered by hand to the offices of the addressee(s).
- ☒ BY MAIL: I am readily familiar with the practice of the office for collection and processing of correspondence for mailing with the United States Postal Service. Under that practice, correspondence is put in the office outgoing mail tray for collection and is deposited in the U.S. Mail that same day in the ordinary course of business. I am aware that, on motion of the party served, service is presumed invalid if the postal cancellation date or postage meter date is more than one (1) day after the date of deposit for mailing shown on this proof of service.
- ☒ FEDERAL: I declare under penalty of perjury under the laws of the United States that the foregoing is true and that I am employed in the office of a member of the Bar of this Court at whose direction the service was made.

Executed on February 28, 2006 at Fountain Valley, California.

  
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